

Application No. 09/680,612
Paper filed April 16, 2007
Reply to Office Action mailed January 16, 2007

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REMARKS

Status Summary

Claims 1-32 are pending in the present application, with claims 1, 9, 14, and 22 presented in independent form. Claims 9-21 are allowed. Claims 1- 8 and 22-32 stand rejected under 35 U.S.C § 112, first paragraph.

Specification

The Office Action objects to the disclosure because of informalities regarding the updating of corresponding patent number information in the Related Applications section. Applicant has amended the specification to correct this informality. Specifically, Applicant has amended the Related Applications section to properly identify Application Serial No. 09/625,824 as U.S. Pat. No. 6,636,259 and Application Serial No. 09/626,418 as U.S. Pat. No. 7,117,519.

The Office Action objects to the Abstract of the disclosure because the amended Abstract was not on a separate sheet. Applicant has amended the Abstract to correct typographical errors and to correctly place the Abstract on a separate sheet.

The Office Action objects to the Amendment filed 6/22/06 for introducing new matter into the disclosure. Specifically, the Office Action states that "the action list 48 stored on the database 20 under a user's account can be downloaded to the user's camera 14" is new matter which is not supported by the original disclosure as filed. Applicant respectfully disagrees.

Support for this material can be found throughout the application as originally filed. Specifically, the material includes subject matter described in U.S. Patent Application Serial No. 09/626,418 now U.S. Pat. No. 7,117,519, entitled "Method And System For Selecting Actions To Be Taken By A Server When Uploading Images," which is assigned to the assignee of the present application and which was

incorporated by reference into this application upon filing ("the '519 patent"). In particular, the material added by the previous amendment may be found at column 8, lines 7-22, of the '519 patent. That portion includes the following statement, "the action list 48 stored on the database 20 under a user's account 40 are automatically downloaded to the user's camera 14."

Applicant has copied subject matter from the '519 patent, which was properly incorporated by reference at the time of filing, into this application to comply with the written description requirement of 35 U.S.C. § 112, first paragraph. The added material differs from the above referenced portion of the '519 patent only in that the added material states "can be downloaded" rather than "are automatically downloaded" as stated in the '519 patent. Applicant respectfully asserts that the phrase "can be downloaded" is supported by the phrase "are automatically downloaded." The word "can" is defined as "to be able to; have the ability, power, or skill to." (See, e.g., the online entry at the URL "<http://dictionary.reference.com/browse/can>"). Thus, a meaning of the phrase "can be downloaded" is that an ability for the action list to be downloaded exists. If an action list is "automatically downloaded" there must be an ability for the action list to be downloaded. Accordingly, Applicant respectfully asserts that the added material is supported by the original disclosure. Accordingly, no new matter has been added.

Further, the Office Action objects to the material found in claim 1 "receiving...action information including at least one action that can be applied by the server to the uploaded images." Claim 22 includes an analogous recitation, "downloading action information including at least one action that can be applied by the server to the uploaded images" that is also objected to as not being supported by the original application. Applicant respectfully disagrees.

Support for the claims, as amended in the paper filed 6/22/06, can be found throughout the application as originally filed. Specifically, the claims include subject matter described in the paragraph added to the specification in the 6/22/06 amendment.

As discussed above, the added paragraph includes subject matter described in the '519 patent, which is assigned to the assignee of the present application and which was incorporated by reference into this application upon filing.

The portion of the '519 patent copied into this application includes the following subject matter: "an action list 48 includes one or more items representing actions that the gateway server 18 should take with respect to uploaded images." As stated above, the '519 patent also includes the subject matter: "the action list ... downloaded to the user's camera 14."

The recitation "action information including at least one action that can be applied by the server to the uploaded images," found in both claim 1 and claim 22, is objected to as not being supported by the original application. The paragraph added to the specification in the 6/22/06 amendment provides support for this recitation. As stated above, the '519 patent that was incorporated by reference into this application upon filing provides support for the paragraph added to the specification.

The '519 patent describes that "an action list 48 includes one or more items representing actions that the gateway server 18 should take with respect to uploaded images." The recitation "action information" is supported by the phrase "action list." The recitation "including at least one action" is supported by the phrase "includes one or more items representing actions." The recitation "that can be applied by the server to the uploaded images" is supported by the phrase "the gateway server 18 should take with respect to uploaded images." Accordingly, the recitation "action information including at least one action that can be applied by the server to the uploaded images," found in both claim 1 and claim 22, is supported by the original application. Applicant respectfully asserts that no new matter has been added.

The recitation "downloading action information to the image capture device" found only in claim 22 is objected to as not being supported by the original application. The paragraph added to the specification in the 6/22/06 amendment provides support for this recitation. As stated above, the '519 patent that was incorporated by reference

into this application upon filing provides support for the paragraph added to the specification. The '519 patent describes that "the action list 48 stored on the database 20 under a user's account 40 are automatically downloaded to the user's camera 14." As stated above, the recitation "action information" is supported by the phrase "action list." The recitation "downloading" is supported by the phrase "are automatically downloaded." The recitation "to the image capture device" is supported by the phrase "to the user's camera." Accordingly, the recitation, "downloading action information to the image capture device" is supported by the original application as filed. Applicant respectfully asserts that no new matter has been added.

In view of the above, Applicant requests that the Examiner reconsider and withdraw the objections raised against the specification.

Claim Rejections

Claims 1-8 and 22-32 stand rejected under 35 U.S.C. § 112 first paragraph as failing to comply with the written description requirement. The Office Action states that the claims contain subject matter which was not described in the specification. Specifically, the Office Action states the terminology "downloading action information including at least one action that can be applied by the server to the uploaded images" is not in the original specification.

Applicant respectfully disagrees. As discussed above, support for the amended claims can be found throughout the application as originally filed. Specifically, the claims include subject matter described in the paragraph added to the specification in the 6/22/06 amendment. As discussed above, the added paragraph includes subject matter described in the '519 patent, which is assigned to the assignee of the present application and which was incorporated by reference into this application upon filing.

The added paragraph describes the following subject matter, "an action list 48 includes one or more items representing actions that the gateway server 18 should take

with respect to uploaded images." As stated above, the added paragraph also describes the subject matter, "the action list ... downloaded to the user's camera 14."

As discussed above, the recitation "downloading" is supported by the phrase "are automatically downloaded." The recitation "action information" is supported by the phrase "action list." The recitation "to the image capture device" is supported by the phrase "to the user's camera." The recitation "including at least one action" is supported by the phrase "includes one or more items representing actions." The recitation "that can be applied by the server to the uploaded images" is supported by the phrase "the gateway server 18 should take with respect to uploaded images." Thus, the recitation "downloading action information to the image capture device including at least one action that can be applied by the server to the uploaded images" found in both claim 1 and claim 22 is supported by the original application. Accordingly, Applicant respectfully asserts that the subject matter in the claims was described in the specification at the time the application was filed, and requests that the Examiner reconsider and withdraw the rejection based on Section 112.

CONCLUSION

In view of the above, and noting that no outstanding art rejections remain, it is respectfully submitted that the present application is now in proper condition for allowance, and an early notice to such effect is earnestly solicited. The Examiner is encouraged to telephone the undersigned patent attorney at the below-listed number if, after reviewing the above Remarks, the Examiner believes outstanding matters remain that may be resolved without the issuance of a subsequent Official Action.

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DEPOSIT ACCOUNT

The Commissioner is hereby authorized to charge any additional fees, or credit any overpayment, associated with the filing of this paper to Deposit Account No. 50-3512.

Respectfully submitted,

Date: April 16, 2007

By: /John A. Demos/

John A. Demos
Registration No. 52,809

Customer No: 49278
111 Corning Road; Ste. 220
Cary, North Carolina 27518
919 233 1942 x219 (voice)
919 233 9907 (fax)